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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,920	07/07/2003	Nathali Mougin	05725.1223-00	6945
22852 7590 05/24/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP			EXAMINER	
			GEORGE, KONATA M	
901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER
		1616		
			MAIL DATE	DELIVERY MODE
			05/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)		
		10/612,920	MOUGIN ET AL.		
	Office Action Summary	Examiner	Art Unit		
		Konata M. George	1616		
Period fo	The MAILING DATE of this communication app or Reply	ears on the cover sheet with the	correspondence address		
A SH WHIC - External afternal - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DANSIONS of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. Operiod for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION  36(a). In no event, however, may a reply be will apply and will expire SIX (6) MONTHS from the cause the application to become ABANDO	ON. It imply filed  om the mailing date of this communication.  NED (35 U.S.C. § 133).		
1)⊠	Responsive to communication(s) filed on 25 Fe	ebruary 2007.			
·	This action is <b>FINAL</b> . 2b) ☐ This action is non-final.				
'=	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is				
	closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11,	453 O.G. 213.		
Dispositi	ion of Claims				
5)□ 6)⊠ 7)□ 8)□ <b>Applicat</b> i	Claim(s) 1-53 is/are pending in the application.  4a) Of the above claim(s) is/are withdraw Claim(s) is/are allowed.  Claim(s) 1-53 is/are rejected.  Claim(s) is/are objected to.  Claim(s) are subject to restriction and/or ion Papers  The specification is objected to by the Examine The drawing(s) filed on is/are: a) access	vn from consideration.  r election requirement.	o Evaminor		
10)	Applicant may not request that any objection to the	•			
11)□	Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Ex	ion is required if the drawing(s) is	objected to. See 37 CFR 1.121(d).		
Priority ι	under 35 U.S.C. § 119				
12)⊠ a)i	Acknowledgment is made of a claim for foreign  All b) Some * c) None of:  1. Certified copies of the priority documents  2. Certified copies of the priority documents  3. Copies of the certified copies of the prior  application from the International Bureau  See the attached detailed Office action for a list	s have been received. s have been received in Applica ity documents have been recei i (PCT Rule 17.2(a)).	ation No ived in this National Stage		
	e of References Cited (PTO-892)	4) Interview Summa			
3) 🛛 Infor	e of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO/SB/08) r No(s)/Mail Date <u>2/28/07</u> .	Paper No(s)/Mail 5) Notice of Informa 6) Other:			

U.S. Patent and Trademark Office PTOL-326 (Rev. 08-06)

## **DETAILED ACTION**

Claims 1-47 are pending in this application.

#### Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on February 28, 2007 was noted and the submission is in compliance with the provisions of 37 CFR 1.97.

Accordingly, the examiner has considered the information disclosure statement.

## **Action Summary**

- 2. The provisional rejection of claims 1-13 and 26-53 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-47 of copending application 10/612,916 is hereby withdrawn as applicant has filed a terminal disclaimer.
- 3. The rejection of claims 1-53 under 35 U.S.C. 102(e) as being anticipated by de la Poterie is being maintained for the reasons stated in the office action dated August 25, 2006.
- 4. The rejection of claims 1-24 and 47-53 53 under 35 U.S.C. 102(e) as being anticipated by de la Poterie is hereby withdrawn in view of applicants arguments.

# Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-53 are rejected under 35 U.S.C. 102(e) as being anticipated by de la Poterie (US 6,113,925).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

de la Poterie discloses a method of forming a film, which may be used as a nail varnish comprising a film former in an aqueous medium (abstract). Column 4, lines 25-40 disclose the film-forming materials such as polyurethane, acrylic, vinylic or styrene-acrylic polymers and that the film-formers can be present in an amount ranging from 2% to 60%. Additional additives, adjuvants, excipients, etc. can be added to the composition such as organic solvents i.e. ketenes (col. 3, lines 25-26), pigments (col. 4, lines 60-62) and UV screening agents, preservatives or wetting agents (col. 5, lines 6-16). The examples teach using SANCURE® as a film-former, since SANCURE® is a known polyurethane then it would have all the properties as claimed by applicant. The

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functional language as claimed by applicant would be inherent to the composition of de la Poterie as the prior art teaches the same composition.

#### Response to Arguments

6. Applicant's arguments filed February 23, 2007 have been fully considered but they are not persuasive.

The applicant argues that de la Poterie does not teach the claimed invention. The examiner disagrees. The instant invention is directed towards a composition comprising a cosmetically acceptable medium and at least one film-forming polymer. The amendment to claim 1, requiring that the polymer "is soluble in an organic solvent..." merely further describes characteristics of the polymer. Paragraphs [0036-0040] and the exemplified example of the applicant's specification describes examples of the claimed film-forming polymer i.e. polyurethanes, polyureas, etc. Column 4, lines 25-40 of de la Poterie teaches examples of film-forming materials that can be employed in the composition of which polyurethanes are mentioned. Since polyurethane is mentioned in the prior art as the film-forming polymer and is taught by applicant as an example in the instant invention, it is anticipated that it would have the same characteristics as claimed. The applicant does not teach in the specification examples of a cosmetically acceptable medium, therefore, any of the cosmetically acceptable mediums known in the cosmetic art can be employed with a reasonable expectation of success. Since the composition of the instant invention and of de la Poterie are the same all of the limitations would be inherent.

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#### Conclusion

7. Claims 1-53 remain rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Telephone Inquiries

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Konata M. George, whose telephone number is 571-

272-0613. The examiner can normally be reached from 8AM to 6:30PM Monday to

Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Johann Richter, can be reached at 571-272-0646. The fax phone numbers

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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you have question on access to the Private Pair system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Konata M. George Patent Examiner

**Technology Center 1600** 

Supervisory Patent Examiner

Technology Center 1600